

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 8

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL M. FROMM

Appeal No. 96-3992
Application 08/356,618¹

ON BRIEF

Before JERRY SMITH, BARRETT, and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1, 5, and 9-14². Claims 3, 4, 7, and 8 have been indicated as containing allowable subject matter. Claims 2 and 6 have been

¹ Application for patent filed December 15, 1994.

² Claim 10 is included in this appeal although it does not appear in the reproduction of the claims on appeal in the Appendix at page 9 of the Brief.

canceled.

The claimed invention relates to an apparatus for applying offset preventing liquid to a contact fuser for fixing powder images to a substrate. Included is a donor brush which is in contact with a metering member and the contact fuser for conveying release agent material to the contact fuser. Appellant states at page 5 of the specification that, to minimize the problem of oil accumulation, a barrier layer is included intermediate an oil permeable sleeve and a nip forming layer of the donor brush as illustrated in Figure 2 of the drawings.

Claim 1 is illustrative of the invention and reads as follows:

1. Apparatus for applying offset preventing liquid to one member of a contact fuser for fixing powder images to a substrate, said apparatus comprising:

a supply of release agent material;

a release agent metering member supported for contact with said supply of release agent material;

means for effecting movement of said metering member in an endless path at different surface velocities;

donor brush supported in contact with said metering member and a fuser member of said contact fuser for conveying release agent material from the former to the latter, said donor brush structure comprising a rigid core, a nip forming layer adhered to said core and sleeve covering said nip forming layer; and

a release agent barrier layer disposed intermediate said sleeve and said nip forming layer for minimizing amount of release agent absorbed by said nip forming layer.

The Examiner relies on the following references:

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Fromm et al. (Fromm)	5,200,786	Apr. 06, 1993
Kato et al. (Kato)	5,232,499	Aug. 03, 1993

Claim 5 stands rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Kato. Claims 1 and 9-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fromm in view of Kato.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief and Answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Brief along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

We note that, despite nominally indicating that all claims stand or fall together in a single group (Brief, page 5), Appellant has provided separate arguments for each of the independent claims 1 and 5. Since the Examiner also has addressed each of independent claims 1 and 5 individually, we will consider these claims separately to the extent that separate arguments are of record in this appeal. Further, since Appellant has made no separate arguments with respect to

any of the dependent claims 9-14, we will consider the dependent claims to stand or fall together with their respective base claim. Accordingly, dependent claims 9-11 will stand or fall with claim 5 and dependent claims 12-14 will stand or fall with claim 1.

It is our view, after consideration of the record before us, that the disclosure of Kato fully meets the invention as recited in claim 5 (with which dependent claims 9-11 fall together). We are also of the view that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in independent claim 1 (with which dependent claims 12-14 stand together). Accordingly, we affirm-in-part.

We consider first the rejection of independent claim 5 under 35 U.S.C. § 102(b) as anticipated by Kato. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Assoc. Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claim 5, the Examiner has indicated how the various limitations

are read on the disclosure of Kato (Answer, page 3) making particular reference to Figure 1 of the drawings. In response, Appellant's arguments center on an alleged deficiency of Kato in disclosing a release agent barrier disposed intermediate the sleeve and the nip forming layer which surrounds and adheres to the core of the donor structure. The relevant portion of Appellant's claim 5 recites:

a release agent barrier layer disposed
intermediate said sleeve and said nip
forming layer for minimizing permeation
of release agent material into said nip
forming layer.

To meet this particular claim limitation, the Examiner (Answer, page 3) has pointed to reinforcing layer 18 in Kato which is intermediate a sleeve 16 and a nip forming layer 14 as illustrated in Figure 1.

After reviewing Appellant's arguments (Brief, page 6), we note that Appellant does not contest the Examiner's position that Kato's reinforcing layer 18 functions as a release agent barrier. Appellant argues, however, that the structure of Kato functions to control release agent flow from the nip-forming layer 14 in contrast with the claimed invention which controls flow into the nip forming layer. In Appellant's view, therefore, Kato's structure can not be said to anticipate the claimed invention since such structure does not function in substantially the same way as the recited elements in claim 5.

In response, the Examiner, citing Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Int. 1987), argues at pages 5 and 6 of the Answer that the recited phrase "for minimizing permeation of release agent material into said nip forming layer" is a statement of intended use which would not

differentiate the claimed structure from prior art which meets the structural requirements. We are in agreement with the Examiner. There are no reasons on the record before us, and Appellant has provided none, to question the Examiner's position that Kato's reinforcing layer 18 functions as a release agent barrier. As the Examiner has concluded, whether release agent is intended to flow into or from such barrier is irrelevant in a claim drawn to the structure of a donor brush. Accordingly, the Examiner's rejection of claim 5 as anticipated by Kato is sustained. Further, since dependent claims 9-11 stand or fall with independent claim 5, the rejection of claims 9-11 is sustained as well.

We now consider the 35 U.S.C. § 103 rejection of independent claim 1 as being unpatentable over the combined teachings of Fromm and Kato. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1,17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825(1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227

USPQ 657, 664 (Fed. Cir. 1985), cert.denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's obviousness rejection of independent claim 1, Appellant asserts (Brief, page 7) a lack of support or motivation in the references for combining or modifying teachings to establish a prima facie case of obviousness. The Examiner has sought to modify the donor brush in the release agent management system of Fromm by relying on Kato for supplying the missing teaching of a release agent barrier layer intermediate the sleeve and the nip forming layer. In the Examiner's view (Answer, pages 5 and 7), the desire to strengthen the donor roll of Fromm would serve as a motivating factor to one of ordinary skill to look to add a reinforcing barrier layer as taught by Kato.

After careful review of the Fromm and Kato references, we are in agreement with Appellant's stated position in the Brief. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The roll separation problem sought to be overcome by Kato does not appear to exist in Fromm since there is nothing in the disclosure of Fromm to indicate that lack of strength or durability of the

donor roller was ever a problem. As to the Examiner's "belief" (Answer, page 7) that the roller of Fromm would suffer similar separation problems as that of Kato, we find such observation to be pure speculation lacking any support on the record. We can find no motivation for the artisan to apply Kato's reinforcing layer teachings to the donor roll structure of Fromm. The only basis for applying Kato's teachings to the Fromm device comes from an improper attempt to reconstruct the Appellant's invention in hindsight.

Accordingly, we can not sustain the Examiner's obviousness rejection of independent claim 1. Since all of the limitations of independent claim 1 are not suggested by the applied prior art, we can also not sustain the Examiner's rejection of appealed claims 12-14 which depend therefrom.

In summary, the Examiner's rejection is sustained with respect to claims 5 and 9-11 but is not sustained with respect to claims 1 and 12-14. Accordingly, the decision of the Examiner rejecting claims 1, 5, and 9-14 is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JERRY SMITH)	
Administrative Patent Judge)	
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